

USPTO Serial No. 10/792,080 (Docket No. ERIC-013)

REMARKS

Claims 1, 7, 11-20 are pending in this Application, with Claims 2, 3, 4, 5, 6, 8, 9, 10 canceled, with Claims 1, 7, 11, 12, 13, 14 being amended and Claims 21-22 being added. No new matter is added by way of these amendments, and the amendments are supported throughout the Specification and the drawings. Reconsideration of Claims 1, 7, 11-20 and favorable consideration of Claims 21-22 is respectfully requested. The Examiner's rejections will be considered in the order of their occurrence in the Official Action.

Section 1 of the Official Action

The Official Action rejected Claims 2-4, 12-14 under 35 U.S.C. §112, second paragraph. The Applicant has made the corrections in accordance with the Examiner's helpful suggestions.

Section 2 of the Official Action

The Official Action rejected as-filed Claims 1-5, 7-15, 18-20 under 35 U.S.C. §102(b) as being anticipated by Tillotson (U.S. Patent No. 2,120,722). The Applicant respectfully disagrees with this rejection for at least the following reasons.

It is important to first briefly discuss 35 U.S.C. §102 and its application to the present application. Under 35 U.S.C. §102(b), anticipation requires that the prior art reference both (1) disclose, either expressly or under the principles of inherency, every limitation of the claim, and (2) be enabling thus placing the allegedly disclosed matter in the possession of the public.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."¹ "The identical invention must be shown in as complete detail as is contained in the ... claim."² Hence, under 35 U.S.C. §102, anticipation requires that each and every element of the claimed invention be disclosed in

¹ *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

² *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

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the prior art.³ Anticipation also requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.⁴ In addition, the prior art reference must be enabling, thus placing the allegedly disclosed matter in the possession of the public.⁵

Independent Claim 1 has the following features:

1. (Currently Amended) A fisherman gripping glove system, comprising:
a glove member having an inner layer, an intermediate layer and an outer layer; and
a plurality of particulate material contained within said outer layer for facilitating gripping of a fish;
wherein said particulate material is comprised of random structures;
wherein said particulate material is comprised of polygonal structures;
wherein said particulate material is comprised of chippings from a hard material, wherein said hard material is comprised of plastic;
wherein said inner layer is a cloth material, wherein said intermediate layer is a rubber material and wherein said outer layer is a rubber material.

Independent Claim 11 has the following features:

11. (Currently Amended) A fisherman gripping glove system, comprising:
a glove member having an inner layer, an intermediate layer and an outer layer; and
a plurality of particulate material contained within only a palm portion of said outer layer for facilitating gripping of a fish.

Tillotson discloses a "coated article and method of producing" the same. Tillotson does disclose using a rubber coating with materials having a "fibrous nature" or "rubber" within them to assist with gripping. None of the materials disclosed, taught or suggested in Tillotson are a particulate material that is comprised of "chippings from a hard [plastic] material" as is specifically claimed in independent Claim 1. This is a significant feature of independent Claim 1 which provides sufficient gripping of fish because of the "hard" features of the chipped plastic. In addition, the chipped plastic is comprised of "random" and "polygonal structures" that

³ *W.L. Gore & Assocs. v. Garlock, Inc.*, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

⁴ *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984).

⁵ *Akzo N.V. v. United States Int'l Trade Comm'n*, 1 USPQ 2d 1241, 1245 (Fed. Cir. 1986), cert. denied, 482 U.S. 909 (1987) (emphasis added).

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increase the gripping of the fish by penetrating the fish better. Tillotson simply does not teach or suggest the usage of "random" and "polygonal structures."

With respect to independent Claim 11, the word "only" has been added to emphasize that Claim 11 is directed towards a glove system having the particulate material "within only a palm portion of said outer layer." This provides for gripping of the fish with the palm while not providing a rough outer portion when being worn by the user making the gloves suitable for long-term wearing instead of short-term usage.

The Applicant respectfully submits that Tillotson does not qualify as appropriate prior art under 35 U.S.C. §102(b) as Tillotson does not disclose (expressly or inherently) all of the features of independent Claims 1, 11. Therefore, Applicant respectfully submits that independent Claims 1, 11 are patentable over the cited reference for at least these reasons. Accordingly, Applicant respectfully requests that the Examiner withdraw the outstanding rejection as applied to independent Claims 1, 11, since the application is in condition for allowance.

Section 3 of the Official Action

The Official Action rejected Claims 6, 16, 17 under 35 U.S.C. §103(a) as being unpatentable over Tillotson in view of Watanabe. The Applicant respectfully disagrees with this rejection of these claims for at least the following reasons.

I. Burden on Examiner to Establish Prima Facie Case

In proceedings before the United States Patent and Trademark Office, the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art.⁶ When references cited by the Examiner fail to establish a *prima facie* case of obviousness, the rejection is improper and will be overturned upon appeal.⁷ "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to

⁶ *In re Bell*, 26 USPQ2d 1529, 1530 (Fed. Cir. 1993). *In re Oetiker*, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

⁷ *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

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why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.”⁸

“To establish a *prima facie* case of obviousness, three basic criteria must be met.”⁹ First, there must be some **suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a **reasonable expectation of success**. Finally, the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.¹⁰

ii. Legal Requirements for Obviousness

“Precedent requires that to find a combination obvious there must be some teaching, suggestion, or motivation in the prior art to select the teachings of separate references and combine them to produce the claimed combination.”¹¹ “An explicit teaching that identifies and selects elements from different sources and states that they should be combined in the same way as in the invention at issue, is rarely found in the prior art.”¹² “As precedent illustrates, many factors are relevant to the motivation-to-combine aspect of the obviousness inquiry, such as the **field of the specific invention, the subject matter of the references, the extent to which they**

⁸ *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

⁹ MPEP §706.02(j).

¹⁰ *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

¹¹ *In re Johnston*, 435 F.3d 1381, 2006 WL 213719 (Fed. Cir. 2006) (citing *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1385 (Fed. Cir. 2001) (“In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention.”); *In re Dance*, 160 F.3d 1339, 1343 (Fed.Cir.1998) (“When the references are in the same field as that of the applicant's invention, knowledge thereof is presumed. However, the test of whether it would have been obvious to select specific teachings and combine them as did the applicant must still be met by identification of some suggestion, teaching, or motivation in the prior art, arising from what the prior art would have taught a person of ordinary skill in the field of the invention.”); *In re Fine*, 837 F.2d 1071, 1075 (Fed.Cir.1988) (there must be “some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references”); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed.Cir.1985) (“When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself.”).

¹² *Id.*

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are in the same or related fields of technology, the nature of the advance made by the applicant, and the maturity and congestion of the field."¹³ Obviousness requires proof "that the skilled artisan ... would select the elements from the cited prior art references for combination in the manner claimed."¹⁴

It is further submitted that combining elements from different prior art references must be motivated or suggested by the prior art.

'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting from *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577; 221 USPQ 929, 933 (Fed. Cir. 1984)).

It is also submitted that the mere fact that one may argue that the prior art is capable of being modified to achieve a claimed structure does not by itself make the claimed structure obvious -- there must be a motivation provided by the prior art.

The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape *** since *this is within the capabilities of such a person.*" Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or the case law which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason.

¹³ *Id.*

¹⁴ *In re Rouffet*, 149 F.3d 1350, 1358 (Fed.Cir.1998).

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Ex parte Gerlach and Woerner, 212 USPQ 471, (PTO Bd. App. 1980) (emphasis in original).

iii. Analysis

a. Non-Analogous

The Applicant respectfully submits that Watanabe is non-analogous to the present invention. "The determination that a reference is from a non-analogous art is . . . twofold. First, we decide if the reference is **within the field of the inventor's endeavor**. If it is not, we proceed to determine whether the reference is **reasonably pertinent to the particular problem with which the inventor was involved**." *In re Wood*, 202 USPQ 171, 174 (C.C.P.A. 1979). "A reference is **reasonably pertinent** if . . . it is one which, because of the matter with which it deals, logically would have commended itself to the inventor's attention in considering his problem. . . . If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, . . . [i]f it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it." *In re Clay*, 23 USPQ 2d 1058, 1060-61 (Fed. Cir. 1992).

The Applicant also respectfully submits the following case law in support that the prior art stated in the Official Action is non-analogous:

- "In resolving the question of obviousness under 35 USC 103, we presume full knowledge by the inventor of all the prior art in the field of his endeavor. However, with regard to prior art outside the field of his endeavor, we only presume knowledge from those arts reasonably pertinent to the particular problem with which the inventor was involved. . . . The rationale behind this rule precluding rejections based on combination of teachings of references from nonanalogous arts is the realization that an inventor could not possibly be aware of every teaching in every art." *In re Wood*, 202 USPQ 171, 174 (C.C.P.A. 1979).
- "In the instant application, the examiner has done little more than cite references to show that one or more elements or subcombinations thereof, when each is viewed in a vacuum, is known. The claimed invention, however, is clearly directed to a combination of elements. That is to say, appellant does not claim that he has invented one or more new elements but has presented claims to a new combination of elements. To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. . . . Based upon the record before us, we are convinced that the artisan would not have found

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it obvious to selectively pick and choose elements or concepts from the various references so as to arrive at the claimed invention without using the claims as a guide. It is to be noted that simplicity and hindsight are not proper criteria for resolving the issue of obviousness." *Ex parte Clapp*, 227 USPQ 972, 973 (B.P.A.I. 1985).

- "We have reminded ourselves and the PTO that it is necessary to consider "the reality of the circumstances" . . . — in other words, common sense—in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor." *In re Oetiker*, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992).
- "The Allen-Bradley art is not in the same field of endeavor as the claimed subject matter merely because it relates to memories. It involves memory circuits in which modules of varying sizes may be added or replaced; in contrast, the subject patents teach compact modular memories. . . . Wang's SIMMs were designed to provide compact computer memory with minimum size, low cost, easy repairability, and easy expandability. . . . In contrast, the Allen-Bradley patent relates to a memory circuit for a larger, more costly industrial controller. . . . Thus, there is substantial evidence in the record to support a finding that the Allen-Bradley prior art is not reasonably pertinent and is not analogous." *Wang Labs., Inc. v. Toshiba Corp.*, 26 USPQ 2d 1767, 1773 (Fed. Cir. 1993).

Watanabe teaches a "porous glove" for use by workers and motorcyclists made of fabric material with a coating layer. Watanabe (permeable gloves for motorcycle riders) is **not** within the field of the inventor's endeavor (non-permeable fishing gloves for gripping fish). Watanabe is also **not** reasonably pertinent to the particular problem with which the inventor was involved (i.e. gripping fishing).

b. Non-Obviousness

First, there is **no suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Tillotson or to combine Tillotson with Watanabe. Second, there is **no reasonable expectation of success**. Finally, the references when combined do **not teach or suggest all** the claim limitations (e.g. particulate material in only the palm portion).

For these reasons, among others, the combination of Tillotson with Watanabe cannot suggest the combination of features in applicant's claims, and it is therefore submitted that the rejection against these claims should be withdrawn.

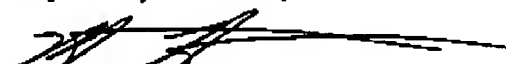
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CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited. Should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, they are invited to telephone the undersigned.

In addition, it is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Respectfully submitted,


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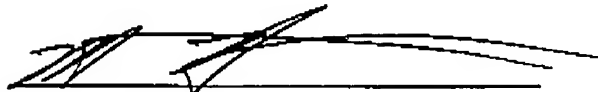
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CERTIFICATE OF FACSIMILE

I hereby certify that this correspondence is being faxed to Examiner Katherine Moran
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